

REMARKS

Remarks which set forth, on a claim by claim basis, specific errors in the Office Action, are set forth below. Based on those remarks, the applicants request that the pending rejections be withdrawn, and that the claims be allowed in their current form.

Claim 1

Claim 1 is directed to a computerized method for billing for web services which comprises configuring a handler to monitor a web service network communication between a service requestor and a service provider for a predefined element in a descriptor file. In the Office Action, claim 1 was rejected as obvious over U.S. published application 2002/0143819 (“Han”) in view of U.S. patent 4,975,942 (“Zebryk”). In response, while not conceding that the rejection of claim 1 in its unamended form was proper, the applicants have amended claim 1 to recite that the handler configured to monitor for the predefined element in the descriptor file is located at the service requestor or the service provider. As set forth below, the applicants submit that the new limitations added to claim 1 are clearly not taught or suggested in either Han or Zebryk, and therefore that the rejection of claim 1 as obvious over those references must be withdrawn.

With respect to Han not teaching the new limitations of claim 1, in the Office Action, paragraphs 14, 149, and 159-61 of Han were cited as teaching configuring a handler to monitor a network communication for a predefined element in a descriptor file. Those paragraphs disclose that a syndicator can monitor web service execution to make sure that it is performed consistently with a subscription between a service provider and a service consumer.¹ However, even assuming Han’s monitoring web service execution teaches or suggests monitoring of web service network communications, the syndicator of Han (*see, Han, Figure 4, below*) differs from the handler of claim 1 because the syndicator of Han is

¹ See Han, ¶ 14 (“The syndication server controls and monitors the execution of the offered service in accordance with business agreement, preferably using the industry standard Information and Content Exchange (ICE) protocol for content data transfer and result analysis.”), ¶ 149 (“The syndicator 401 employs a transport manager 421 to communicate with the subscribers 403. ... The transport manager 21 provides an industry standard HTTP “web listener” to receive and send messages.”), ¶ 160 (“the syndicator 401 manages and monitors web service execution in accordance with the terms of the business relationship defined in a ‘subscription.’”).

not located at the service provider or service requestor.

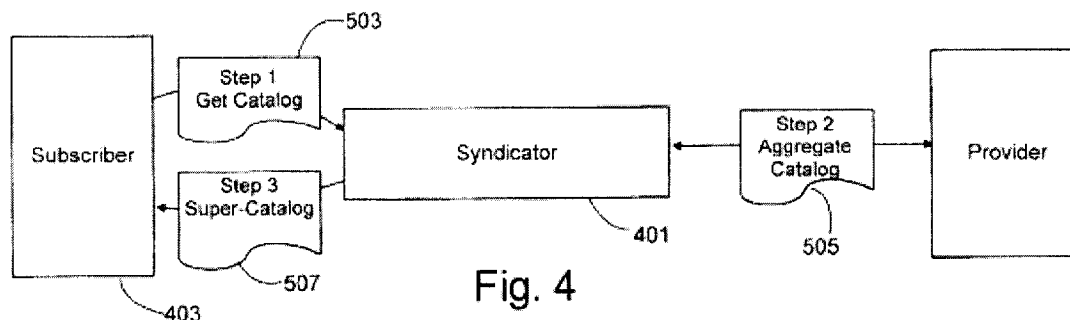


Fig. 4

Han, figure 4, showing the syndicator as existing separately from both the subscriber and provider.

This is consistent with the written disclosure of Han, which indicates that the monitoring functionality of the syndicator requires that the syndicator be located between the subscribers and providers so that they do not communicate directly with each other:

In accordance with a feature of the invention, web service consumers modeled as subscribers access web services via the syndicator 401, rather than on a direct peer-to-peer basis between the consumer and the service provider. In this way, the syndicator 401 manages and monitors web service execution in accordance with the terms of the business relationship defined in a "subscription."²

As a result, the applicants submit that the limitations added to claim 1 are clearly not taught or suggested in Han.

Like Han, Zebryk does not teach or suggest the limitations which have been added to claim 1. Zebryk discloses technology for using credit or calling cards for pay telephone calls.³ In Zebryk, a phone is configured to monitor a call to record when the user hangs up after the user has called the destination number and entered the number for his or her credit card.⁴ In Zebryk, there is no teaching or suggestion of a descriptor file containing predefined elements at all, let alone a teaching or suggestion that a handler, located at a service requestor or service provider, is configured to monitor for such elements. As a result, the applicants submit that the limitations which have been added to claim 1 are clearly not taught or

² Han, ¶ 160.

³ Zebryk, col. 1, ll. 8-10 ("The present invention relates to so-called "pay telephone" systems and methods, being particularly concerned with credit/calling card utilization therewith.")

⁴ Zebryk, col. 3, ll. 15 - 26 ("In summary, from one of its broader aspects, the invention embraces a method of credit/calling card pay telephone communication, that comprises...prompting the user to enter credit/calling card number after dialing the number-to-be-called; locally checking card validity in self-contained local database...[and] monitoring the line until the user terminates the call").

suggested in either Han or Zebryk, and therefore that the rejection of claim 1 as obvious over those references should be reconsidered and withdrawn.

Claims 2-18

In the Office Action, claims 2-18, like claim 1, were each rejected as obvious over the combination of Han and Zebryk. However, the applicants assert that those rejections are flawed, and should be withdrawn for at least the reasons set forth below.

First, the Office Action failed to make out a prima facie case of obviousness for any of claims 2-18, because the sections of the prior art cited in the Office Action, paragraphs 23, 42, 273-77, 302-04, and 316-24 of Han, are simply irrelevant to the current claims.⁵ With respect to paragraph 23, that paragraph describes providing diverse information sources into program accessible services using a standard interface. There is no mention of web service billing, configuring a handler, monitoring a communication, or any other limitation recited in claims 2-18 in paragraph 23 of Han. Similarly, paragraph 42 of Han is simply a definition of a “Service Provider.” While a service provider could use the subject matter described in the present claims, simply stating that a “Service Provider” exists (rather than, disclosing, for example, configuring a handler, monitoring a communication, etc) does not teach or suggest any limitations of the current claims. Finally, paragraphs 273-77, 302-04, and 316-24 do not teach or suggest the limitations in the current claims because the paragraph numbering in Han extends only to paragraph 204. Accordingly, paragraphs 273-77, 302-04 and 316-24 of Han do not exist, and cannot properly be cited in any of the pending rejections. Thus, the rejections of claims 2-18 should be withdrawn for at least the reason that the sections of the prior art cited against those claims are entirely irrelevant.

Second, at least for claims 2-15, the rejections of those claims should also be withdrawn because each of those claims depends, either directly or indirectly, from claim 1. Thus, because all of the limitations from claim 1 are incorporated into claims 2-15 by virtue of their dependencies, the arguments set forth regarding claim 1 also apply to claims 2-15,

⁵ The applicants note that the previous office action, which was mailed on December 31, 2007, rejected claims 2-18 based on paragraphs 23, 42, 273-77, 302-04, and 316-24 of U.S. Published Application 2005/0216421 (“Barry”). In the event that the current rejections of claims 2-18 are based on cutting and pasting the rejections from the previous office action, and simply replacing the citation to Barry with a citation to Han, the Office Action should be withdrawn as failing to cite the best art known to the Examiner, failing to make a thorough

and the rejections of claims 2-15 should be withdrawn for the reasons given above regarding claim 1.

Third, claims 2-18 each include additional limitations which can be used to distinguish the prior art even if the arguments given above are not accepted. For example, independent claims 16 and 17 both recite limitations of copying predefined elements from a network communication into a record. The most relevant section of the prior art cited in the Office Action appears to be paragraphs 14, 149, and 159-62 of Han, which were cited as teaching claim 1's limitations of configuring a handler to sent pre-defined elements to a set of programmed instructions to create an event record.⁶ As discussed with respect to claim 1, those sections disclose that a syndicator can monitor web service execution to make sure that it is performed consistently with a subscription between a service provider and a service consumer. However, there is no teaching or suggestion that such monitoring includes the copying of pre-defined elements to create a record as recited in claims 16 and 17, demonstrating that the limitations recited in claims 2-18 provide independent reasons for why the rejections of those claims from the Office Action should be reconsidered and withdrawn.

Fourth, in an effort to reach a compromise position with the Examiner, the applicants have amended claims 12 and 18 to recite that the handler is located at the service provider, and that the service requestor accesses the service provider on a direct peer-to-peer basis. While, as set forth above, claims 12 and 18 are not properly rejected in their unamended form, it is beyond cavil that the current form of claims 12 and 18 overcome the combination of Han and Zebryk. In support of this, the applicants note that Han teaches that the operation of the syndicator disclosed in that reference is incompatible with accessing a service provider on a direct peer-to-peer basis.⁷ Thus, it would be improper to reject claims 12 or 18 as

study of the invention and the prior art, and failing to be complete in all matters. *See* 37 C.F.R. 1.104 (Nature of Examination).

⁶ Office Action at 2. The applicants do not concede that those sections of Han actually teach or suggest the limitations from claim 1. Those sections are mentioned only to show that Han does *not* teach or suggest the limitations discussed in the context of claims 16 and 17.

⁷ Han, ¶ 160:

In accordance with a feature of the invention, web service consumers modeled as subscribers access web services via the syndicator 401, **rather than on a direct peer-to-peer basis** between the consumer and the service provider. In this way, the syndicator 401 manages and monitors web service execution in accordance with the terms of the business relationship defined in a "subscription."

(emphasis added). The applicants note that direct access on a peer-to-peer basis does not imply a physical connection directly from the service requestor to the service provider, and that there may be other devices (e.g.,

obvious over any combination of references which includes Han, because modifying Han to obtain the inventions of claims 12 or 18 would be inconsistent with the specific teachings of that reference.

New Claims

In addition to requesting the allowance of claims 1-18, the applicants also request allowance for new claims 19-20. The applicants note that new claims 19-20 depend from claim 16, and therefore incorporate each novel limitation of that claim. The applicants also note that claims 19-20 include limitations (location at the service provider, direct peer-to-peer access) which were discussed above and which are clearly not taught or suggested in the art of record. Therefore, claims 19-20 should be allowed for at least the reasons given above regarding claims 1-18.

Other Amendments

The applicants note that certain minor amendments have been made for the purpose of maximizing the readability and clarity of the claims and description. In the description, paragraph 23 is amended by replacing it with a new paragraph that explicitly differentiates between the service description and service discovery stacks. In the claims, claim 1 has been amended to replace references to “at least one” predefined element with “a” predefined element. Similarly, the use of the construction “element(s)” from claim 1 has been removed. These changes are made to improve readability, and are not intended to limit claim 1 to embodiments with only a single predefined element, or to surrender protection for computerized methods which would otherwise fall within the scope of claim 1.⁸ Corresponding changes are made in claims 4 and 14. Additionally, claim 9 has been amended so that it now depends from claim 6, rather than claim 7. Similarly, claim 16 has

routers, switches) on the communication path between those entities. However, unlike in Han, in the direct peer-to-peer access scenario, the logical communication path would not include the intermediary syndicator entity. Such a logical communication path is depicted in figures 9, 10, and 12-14 of the application as originally filed.

⁸ The applicants note that Federal Circuit case law makes clear that the word “a” in a patent claim can encompass embodiments with more than one instance of an element. *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). (“This court has repeatedly emphasized that an indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’”)

been amended to correct an obvious typographical error in which the word “tiered” in the phrase “tiered plans” was misspelled. None of the above changes should be treated as narrowing the scope of the claims, or otherwise surrendering protection over subject matter covered by the claims in their current form.

Support for Amendments

The applicants submit that no new matter is added by the current amendments, and that support for those amendments can be found in at least the claims, paragraphs 104 and 106, and figures 3, 9, 10, and 12-14 of the application as originally filed.

CONCLUSION

In light of the arguments made herein, it is respectfully submitted that the claims of the present application meet the requirements of patentability under 35 U.S.C. § 103(a). Accordingly, reconsideration and allowance of these claims are earnestly solicited. Further, the applicants submit that the above discussion does not constitute an exhaustive list of novel limitations or reasons why the pending claims should be allowed. To the extent that applicants have not addressed certain aspects of the present rejection, or seem to have adopted certain aspects of the present rejection in the arguments made herein, please do not construe the same as an admission as to the merits of the rejections.

If questions persist or additional matters need to be dealt with prior to allowance, the applicants encourage the Examiner to contact their representative, William Morriss, at (513)651-6915, or wmorriss@fbtlaw.com.

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully submitted,

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